Remarks

For the reasons set forth herein, Applicants request that the Examiner reconsider the rejections set forth in the final Office Action. Claims 1-13, 15-41, 43-54 & 56 remain pending.

Initially, Applicants note that the previously stated drawings, specification and claim objections of the first Office Action appear to have been withdrawn based upon Applicants' prior filed Amendment. Further, it is noted that 35 U.S.C. §101 rejections to original claims 1-14, 15-24, 25-30 & 43 appear to have been withdrawn.

Responsive to the final Office Action, Applicants herein amend independent claims 1, 15, 31, 43 & 56 to delete the word "priority". Deletion of this word is believed to render moot the new matter specification objection stated in the final Office Action, as well as the rejection to claims 1-13, 15-24, 31-41, 43 & 56 under 35 U.S.C. §112, first paragraph. Further, Applicants respectfully submit the deletion of the word "priority" does not raise new issues which require further search and/or examination.

In the Office Action, claims 1-13, 15-30 & 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over an article by David Hsu and Tim Bernstein entitled "Managing the University Technology Licensing Process: Findings From Case Studies" (referred to herein as "Hsu"), while claims 31-41, 44-54 & 56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nummelin, et al. (U.S. Patent No. 6,308,164; hereinafter "Nummelin") in view of Hsu. Each of these rejections is respectfully, but most strenuously, traversed and reconsideration thereof is requested.

Applicants request reconsideration and withdrawal of the obviousness rejection on at least the following grounds: (1) the Office Action fails to state a *prima facie* case of obviousness against Applicants' claimed invention: (2) the Office Action has misinterpreted the teachings of Hsu, thus voiding the basis for the rejection; (3) the Hsu reference itself lacks any teaching, suggestion or incentive for its modification as necessary to achieve Applicants' recited invention; and (4) the Hsu article and Applicants' recited invention are fundamentally directed to different problems.

Failure to State a *Prima Facie* Case of Obviousness:

Applicants' invention, in one aspect, is directed to a method for managing resource allocations within an intellectual property portfolio (see claim 1). The method includes:

(i) *determining available resource capacity for an intellectual property activity* managed by a computer tracking system;

(ii) assigning technologies tags to the activity in the computer tracking system, the technology tags representing different technology areas of interest;

(iii) *apportioning the available resource capacity for the activity to the different technology areas of interest* in the computer tracking system based on a value assigned to each technology area of interest;

(iv) *obtaining actual resource usage by technology area* from the computer tracking system; and

(v) employing the computer tracking system to provide a report *indicative of the difference between the actual resource usage and the resource allocation by technology areas of interest for use in managing resource allocation for the intellectual property activity.*

Applicants respectfully submit that numerous aspects of their above-summarized invention are not taught or suggested by Hsu, either alone, or in combination with the apparent Official Notice taken by the Examiner concerning computer tracking systems *per se*.

Initially, Applicants recite "determining available resource capacity for an intellectual property activity . . ." as used in this application, *resource capacity* refers to a quantification of the intellectual property activity. In accordance with dictionary definitions, the word "capacity" means the maximum amount or number that can be contained or accommodated. Thus, Applicants' step of determining available resource capacity for an intellectual property activity means determining the maximum amount of resources or number of resources that can be made available for the intellectual property activity. This is a quantification of available resources. Because the Office Action fails to recognize the above-noted plain meaning of the word "capacity", it is respectfully submitted that there is no *prima facie* case of obviousness against Applicants' recited step of "determining available resource capacity for an intellectual property activity . . ." In this regard, the Office Action appears to equate "potential value of a licensed

invention contrasted with the human resources needed to develop and process invention disclosures, patents, licenses, etc." as being analogous to Applicants' step of *determining available resource capacity for an intellectual property activity*. Since this Office Action statement does not address determining resource capacity *per se*, wherein capacity refers to an evaluation of the amount or number of resources that can be made available, no *prima facie* case of obviousness is stated.

Further, Applicants respectfully submit that a *prima facie* case of obviousness is not stated in the Office Action in connection with their independent claims since the independent claims further recite *apportioning the available resource capacity for the activity to the different technology areas of interest.* In this regard, the Office Action analogizes "decisions to file a patent application for or to license an invention disclosure" as meeting Applicants recited functionality. This assertion is believed clearly deficient and not applicable to the recited function. As noted above, the available resource capacity refers to an amount of resources or number of resources that are available for the intellectual property activity. The word "apportioning" means "to make a proportionate division or distribution of". In Applicants' claimed process, the available resource capacity for the activity is divided among the different technology areas of interest in the computer tracking system. The page 3, paragraph 3 citation of Hsu describing an individual decision whether or not to file a patent application is a distinct process from Applicants' recited functionality. Applicants recite *apportioning the capacity* (i.e., the maximum amount of number of resources that can be made available) to the different technology areas of interest.

Additionally, the Office Action appears to redefine the resources or resource capacity of Hsu from that alleged in Applicants' first step of determining available resource capacity for the intellectual property activity. In the determining step, the Office Action analogizes Hsu's "potential value of a licensed invention contrasted with the human resources needed to develop and process invention disclosures, patents, licenses, etc.", while when apportioning the available resource capacity for the activity to the different technology areas, the Office Action analogizes Hsu's "decisions to file a patent application for or to license an invention disclosure". This inconsistency is believed to further support Applicants position that a *prima facie* case of obviousness is not stated in the final Office Action against the independent claims presented.

Still further, Applicants respectfully submit that a *prima facie* case of obviousness is not stated in the final Office Action in connection with their recited function of providing a report *indicative of the difference between the actual resource usage and the resource allocation by technology areas of interest for use in managing resource allocation for the intellectual property activity*. In Applicants' recited process, there is an apportioning or allocation of the available resource capacity for the activity to the different technology areas of interest, and then a determination of the difference between the actual resource usage and the resource allocation by technology areas of interest. In order to provide a report indicative of a difference, there must be a difference to track. In the Office Action, it appears that there is an assertion of a *de facto* apportioning of resources based on a decision whether to file a patent application or to license an invention disclosure. However, this *de facto* apportioning necessarily equates to the actual distribution of resources, and thus, there is no difference between the actual resource usage and a resource allocation when asserted as presented in the Office Action. As such, there can be no difference between the two using the logic of the Office Action. Thus, there would be no incentive reading Hsu to provide a report indicative of the difference between an actual resource usage and the resource allocation by technology areas of interest. Further, the Office Action generally references generation of a report, but does not describe why the particular report recited by Applicants would have been obvious in view of Hsu. As such, it is respectfully submitted that the final Office Action fails to state a *prima facie* case of obviousness against Applicants' independent claims with respect to the apparent Official Notice stated in the Office Action. Should the Examiner continue to entertain reservations regarding the allowability of the claims presented, then Applicants request that the Examiner more specifically document the Official Notice pursuant to 37 C.F.R. §1.104(d)(2).

For at least the above reasons, Applicants respectfully request reconsideration and withdrawal of the obviousness rejections to the independent claims based on the applied art.

The Office Action Has Misinterpreted The Teachings of Hsu:

As noted, the word "capacity" refers to a quantification of resources, that is, a determination of the maximum amount or number that may be available. A careful reading of Hsu fails to uncover any discussion of determining available resource **capacity** for an intellectual property activity. For example, there is no quantification of the amount of human resources

available to either develop or process an invention disclosure, patent, license, etc. Thus, Applicants respectfully submit that the Office Action misinterprets the teachings of Hsu when alleging therein that there is a determination made of available resource capacity for an intellectual property activity.

Further, Applicants respectfully submit that the Office Action misinterprets the teachings of Hsu when alleging that Hsu describes an apportioning of the available resource capacity for the activity to the different technology areas of interest. As noted above, the word "apportioning" means to make a proportionate division or distribution of. Further, Applicants' proportionate division or distribution refers to the determined available resource capacity. It is the capacity that is being apportioned in Applicants' invention among the different technology areas of interest. Since Hsu does not describe determination of the resource capacity, it is respectfully submitted that there is no apportioning of the determined available resource capacity for the activity to the different technology areas of interest. A decision to file a patent application or to license an invention disclosure is not a resource *per se*, thus, these decisions do not represent an apportionment of a determined resource capacity to different technology areas of interest as recited by Applicants. It is respectfully submitted that there is simply no express apportioning of available resource **capacity** across different technology areas of interest in Hsu, let alone based on a value assigned to each technology area of interest.

For at least the above reasons, Applicants respectfully submit that the Office Action mischaracterizes/misinterprets the teachings of Hsu when alleging the obviousness rejection to their independent claims. Hsu does not disclose Applicants' recited functionality, which includes determining available resource capacity for an intellectual property activity, and apportioning the determined available resource capacity for the activity to the different technology areas of interest. For at least this reason, Applicants respectfully request reconsideration and withdrawal of the obviousness rejection to their independent claims based on the teachings of Hsu and/or Nummelin and Hsu.

The documents themselves lack any teaching, suggestion or incentive for their further modification as necessary to achieve Applicants recited invention:

Neither Hsu nor Nummelin describes Applicants' above-noted processing, which includes determining available resource *capacity* for an intellectual property activity, and the apportioning of this available resource capacity for the activity to the different technology areas of interest.

Upon a review of the Hsu and Nummelin documents, there is no teaching, suggestion or incentive for the further modification as would be necessary to achieve Applicants invention. In this regard, neither document discusses the need addressed by the present invention, that is, the desirability of building a premiere intellectual property portfolio by providing techniques for targeting strategic patent or other intellectual property development opportunities by providing a proactive intellectual property development and measurement approach. To the extent cited in the Office Action, is it noted that Hsu merely describes a case-by-case decision whether to file a patent application or license an invention. As such, a portfolio in Hsu would inherently be the result of reactive managing of resources, rather than a proactive approach as recited in Applicants independent claims.

The present invention and the Hsu article address different goals:

Applicants note that the goal of the Hsu article, and that of the present invention are distinct. In Hsu, it is noted that university Technology Licensing Offices ("TLOs") face a dynamic environment in which the number of technology disclosures is rapidly increasing, while the available resources for licensing technologies do not keep pace. Adapting new, strategic plans for licensing is therefore vital. The Hsu paper therefore develops an analytical framework for the licensing process. Drawing on the analytical framework in case studies, the Hsu article concludes with recommendations to help TLOs continue to improve their licensing strategies in the challenging environment.

In contrast, Applicants invention notes that current intellectual property portfolios are most often developed as a result of solving day-to-day technical problems associated with manufacturing, development, etc. In order to build a premier intellectual property portfolio, techniques for targeting strategic (e.g. products, standards, etc.) patent or other intellectual

property development and opportunities are believed desirable by Applicants, as well as techniques for measuring invention development progress. Applicants' invention addresses these goals by providing a proactive intellectual property development and measurement approach using a computer tracking system and the processing functionality recited by Applicants.

Based on these different goals, Applicants respectfully submit that one of ordinary skill in the art would not have viewed their approach as obvious over the teachings of the Hsu article.

For at least the above reasons, Applicants respectfully request reconsideration and withdrawal of the obviousness rejections to the independent pending claims based on the applied art.

The dependent claims are believed allowable for the same reasons as the independent claims, as well as for their own additional characterizations. For example, claims 2, 32 & 56 further recite using the generated report to proactively manage resource allocation for the intellectual property activity using the determined difference between the actual resource usage and the resource allocation by technology area of interest. The Office Action's reference to historical data is believed clearly distinct from the particular report referenced by Applicants in the claims at issue. In Applicants' invention, there is a difference between the obtained actual resource usage and the apportioned available resource capacity for the activity to the different technology areas of interest. Historical data *per se* would not provide such a difference, and without a difference, there can be no proactive managing of resource allocation based thereon. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection to these claims.

With respect to the obviousness rejection of claims 31-41, 44-54 & 56 over Nummelin in view of Hsu, Applicants respectfully traverse the combination in somehow suggesting their claimed invention. Neither Nummelin nor Hsu disclose numerous aspects of Applicants' approach to managing resource allocations within an intellectual property portfolio. There is simply no *determining of available resource capacity* for an intellectual property activity *per se*, nor is there an *apportioning of that available resource capacity* for the activity to different technology areas of interest. Still further, there is no employing of a computer tracking system to provide a report *indicative of the difference between the actual resource usage and the resource*

allocation by technology areas of interest for use in managing resource allocation for the intellectual property activity. For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this obviousness rejection.

All claims are believed to be in condition for allowance, and such action is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,

Kevin P. Radigan

Kevin P. Radigan
Attorney for Applicants
Registration No.: 31,789

Dated: November 22, 2005.

HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579